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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,675	06/07/2001	Ralf Fischer	1594	9966
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/857,675

**Applicant(s)**

FISCHER ET AL.

**Examiner**

MARCOS L. TORRES

**Art Unit**

2617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-49, 51-70 and 72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-49, 51-70 and 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CC)
- Paper No(s)/Mail Date 7-18-08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 7-18-08 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 7-18-08 was considered during the time given to the examiner. If the applicant believes that a particular document is relevant to the prosecution of the case, the applicant is invited to mention the particular document to the examiner.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 37-42, 44-47, 49, 52-62, 66-68, 70 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara US005604921A in view of Vanttila (U.S. Patent US005794142A) and further in view 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0)

As to claim 37-38, 49 and 74, Alanara discloses a method for transmitting short messages in a radio telecommunications network, comprising the steps of sending a notification message from a central station to the addressed to a subscriber of a telecommunications network as a function of a short message transmitted to the telecommunications network for the subscriber (see col. 1, lines 6-17); transmitting to the subscriber with the notification message, data that includes items of information about a content of the short message; and transmitting to the subscriber as the notification message, a first data field of the short message, which includes the data having the items of information about the content of the short message (see col. 2, lines 1-

8). Alanara does not specifically disclose sending a short message to a central station of a telecommunications network, wherein the notification message is not the short message. In an analogous art, Vanttila discloses sending a short message to a central station of a telecommunications network (see col. 6, line 13-40); wherein the notification message is not the short message (see col. 5, lines 13-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for the simple purpose of saving bandwidth.

Alanara and Vanttila do not specifically disclose that the notification message is not transmitted together and transmitting to the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header Information including at least one item of information about the type of evaluation of the notification message to be performed. In an analogous art, 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) discloses sending the notification separate from the message (SMS-Deliver Report) and transmitting to the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header Information including at least one item of information about the type of evaluation of the notification message to be performed, including a first data field of the short message, which includes the data having the items of information about the makeup and/or the content of the short message. (SMS-COMMAND, STATUS-

REPORT, SMS SUBMIT REPORT; see sec. 9.2.2-9.2.3). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teachings in the modified Alanara and Vantilla to comply with existing standards.

As to claim 39, Vantila discloses a method further comprising transmitting to the subscriber the notification message only after a request signal has been output by the subscriber to the telecommunications network (see col. 6, lines 5-35).

As to claim 40, Vantila discloses a method further comprising providing the first data field of the short message as a text-based data field (see col. 5, lines 16-19).

As to claim 41, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the makeup of the short message about a size of the data fields (see col. 2, lines 4-8).

As to claim 42, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message, indications about presence of various data types and the short message in various data fields of the short message (see col. 2, lines 4-9).

As to claim 44, Alanara discloses a method further comprising reading out at the subscriber the items of information about the makeup and/or content of the short message from a notification message received and shown on a display device (see col. 2, lines 15-23).

As to claims 45 and 46, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout

information about the makeup and/or content of the short message. Vanttila disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout information about the makeup and/or content of the short message (see col. 6, lines 13-20). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for a user-friendly interface.

As to claim 47, Alanara discloses a method further comprising processing the items of information about the content of the short message in a subscriber station of the subscriber (see col. 3, lines 45-52).

As to claim 52, Alanara discloses a method further comprising transmitting the notification message to the subscriber in form of a short message (see col. 1, lines 6-15). Alanara and Vanttila do not specifically disclose transmitting the global system for mobile communications standard. 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) is part of the GSM standard. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this standard or any other equivalent standard for the simple purpose of compatibility.

As to claims 53 and 66-68, Vanttila discloses a method further comprising transmitting the short message to the telecommunications network by a sender, which is a mobile sending station (see col. 6, lines 13-15). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of sending a command.

As to claims 54 and 55, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting from the central station to the telecommunications network an acknowledgment message for the sender, once the short message has been received from the central station. 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) disclose a method further comprising transmitting from the central station to the telecommunications network an acknowledgment message for the sender, once the short message has been received from the central station (see section 9.2.2-9.2.3). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of reliability.

As to claim 56 is a combination of limitations of claims 52 and 55. Therefore they are rejected for the same reason of claims 52 and 55.

As to claim 57, Vanttila discloses a method further comprising transmitting the short message from a central station, which is a network operator for a receiver, which is mobile receiver to the telecommunications network (see col. 6, lines 34-35). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique in order to receive messages.

As to claim 58, Vanttila discloses a method further comprising processing by a command message transmitted to the telecommunications network by the subscriber at least one data field of the short message as a function of the content of the command message (see col. 5, lines 25-50; col. 6, lines 25-32).



As to claim 59, Vanttila discloses a method further comprising preparing the command message at the subscriber as a function of at least one user input at an input unit (see col. 6, lines 13-24).

As to claim 60, Vanttila discloses a method further comprising preparing the command message automatically at the subscriber at the function of the items of information about the content of the short message (see col. 6, lines 13-24).

As to claim 61, Vanttila discloses a method further comprising preparing the command message as a function of command criteria that are specified by the subscriber (see col. 6, lines 13-24).

As to claim 62, Vanttila discloses a method further comprising requesting by the subscriber from the telecommunications network at least one data field of the short message by means of a command message embodied as a selection message and transmitted to the telecommunications network; and transmitting the at least one requested data field of the short message to the subscriber (see col. 6, lines 13-40).

As to claim 70, Alanara discloses a notification message in form of a header information; and further comprising generating from indications about the content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields (see col. 2, lines 1-23). Vanttila discloses a method further comprising transmitting from the central station to the telecommunication network the command message in form of a short message service message (see col. 3, lines 52-55; col. 6, line 13-40) by a global system for mobile communications standard, and the notification message in form of a first item of header information; and further comprising generating from indications about the

content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields(see col. 3, lines 52-55; col. 6, line 13-40). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for the simple purpose of enhanced service.

As to claim 72-73, Alanara discloses a method for transmitting shod messages in a radio telecommunications network, comprising the steps of sending a notification message to a subscriber of a telecommunications network as a function of a short message transmitted to the telecommunications network for the subscriber transmitting to the subscriber with the notification message data that includes items of information about a makeup and/or a content of the short message (see col. 1, lines 6-17); and transmitting to the subscriber as the notification message, a first data field of the short message, which includes the data having the items of Information about the makeup and/of the content of the short message; transmitting with the notification message to the subscriber a first item of header Information and a message, the first item of header information including at least one item of Information about the content of the message, the message including the item of information about the makeup and/or content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose sending a short message to a central station of a telecommunications network, wherein the notification message is not the short message. In an analogous art, Vanttila discloses sending a short message to a central station of a telecommunications network (see col. 6, line 13-40); wherein the notification message is not the short message (see col. 5, lines 13-24). Therefore, it would have been obvious

to one of the ordinary skill in the art at the time of the invention to combine both teachings for the simple purpose of saving bandwidth.

Alanara and Vantilla do not specifically disclose that the notification message is not transmitted with the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header Information including at least one item of information about the type of evaluation of the notification message to be performed. In an analogous art, 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) discloses sending the notification separate from the message (SMS-Deliver Report) and transmitting to the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header Information including at least one item of information about the type of evaluation of the notification message to be performed, including a first data field of the short message, which includes the data having the items of information about the makeup and/or the content of the short message. (SMS-COMMAND, STATUS-REPORT, SMS SUBMIT REPORT; see sec. 9.2.2-9.2.3). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teachings in the modified Alanara and Vantilla to comply with existing standards.

7. Claims 43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vantilla and 3G TS 23.040 V3.3.0 (1999-12) *Technical*

*Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) further in view of Winbladh (U.S. Patent US006205330B1).

As to claim 51, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting to the communication network the short message as a message from an electronic mail surface as an Internet E mail message. In an analogous art, Winbladh discloses a method further comprising transmitting to the communication network the short message as a message from an electronic mail surface as an Internet E mail message (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Alanara system for versatility.

As to claim 43, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose indications about the sender of the data stored in memory of the short message. In an analogous art, Winbladh discloses indications about the sender of the data stored in memory of the short message (see col. 7, lines 6-23). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for enhanced convenience.

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila and 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals;

Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) further in view of Söderbacka (U.S. Patent US006665531B1).

As to claim 48, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting the items of information about the content of the short message for processing to an identity module of the subscriber, issued by a service provider. In an analogous art, Söderbacka discloses a method further comprising transmitting the items of information about the content of the short message for processing to an identity module of the subscriber, issued by a service provider (see col. 4, line 29 – col. 5, line 14). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

9. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) and 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) as applied to claim 58 above, and further in view of Söderbacka.

As to claim 65, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message. In an analogous art, Söderbacka a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message (see col. 6, lines 10-50). Therefore, it would have

been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

10. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) and 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G TS 23.040 version 3.3.0) as applied to claim 67 above, and further in view of Proust (U.S. Patent US006216014B1).

As to claim 69, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message and the notification message by an identity module of the subscriber, which pertains to a service provider. Vanttila discloses a method further comprising preparing a command message, which pertains to a service provider (see col. 6, lines 13-24). In an analogous art, Proust discloses a method further comprising preparing a notification message by an identity module of the subscriber, which pertains to a service provider (see col. 2, lines 12-17). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of having enhanced services.

11. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) and 3G TS 23.040 V3.3.0 (1999-12) *Technical Specification* 3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (3G

TS 23.040 version 3.3.0) as applied to claim 62 above, and further in view of Hansson (U.S. Patent US006400942B1).

As to claims 63 and 64, Alanara discloses a method further comprising transmitting at least two data fields of the short message sequentially (see col. 2, lines 1-8). Alanara does not specifically disclose that are requested by the subscriber by the selection message, simultaneously transmitted. In an analogous art, Hansson discloses transmitting simultaneously (see col. 1, lines 37-40). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for bandwidth management purpose.

### ***Response to Arguments***

Applicant's arguments with respect to claims 37-49, 51-70 and 72 have been further considered in accordance with applicant's submitted IDS but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/  
Examiner, Art Unit 2617